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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/616,849	07/14/2000	Julja Burchard	9301-044	6450

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EXAMINER

FORMAN, BETTY J

ART UNIT

PAPER NUMBER

1634

DATE MAILED: 09/08/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action	Application No. 09/616,849	Applicant(s) BURCHARD, JULJA	
	Examiner BJ Forman	Art Unit 1634	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 07 August 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☐ they raise the issue of new matter (see Note below);
 - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☐ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 27-30,33-36,44-47,59-68,73-75,90,91 and 93.

Claim(s) withdrawn from consideration: _____.

8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____

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Continuation of Advisory Action @5: The request for reconsideration does NOT place the application in condition for allowance because:

Applicant's arguments regarding the rejections presented in the Final Office Action are not found persuasive as discussed below.

Applicant agrees that Lockhart evaluates probe hybridization ability by comparing the hybridization signal between a target sample and the probes to the hybridization signal between a non-target sample and the probe. However, Applicant argues, Lockhart et al do not teach that the signal comparison is via determining a ratio. Applicant's arguments have been considered. However, the rejection is under 35 U.S.C. 103 over Lockhart et al in view of Bao et al. And Bao et al is relied upon for the teaching of determining a ratio. Therefore, Applicant's arguments regarding the deficiency of Lockhart et al are not relevant to the pending rejection.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Applicant further argues that background hybridization in Lockhart et al is not a second sample and claimed. The argument has been considered but is not found persuasive because the instantly claimed "second sample" is defined as comprising a plurality of different polynucleotides. The sample of Lockhart et al meets these requirements and therefore meets the limitations of the claims.

Applicant argues that Bao et al does not teach the claimed invention and there is no teaching in Lockhart that its methods can be combined with Bao. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Bao et al clearly provide the motivation to apply their ratio determination to the hybridization comparison of Lockhart et al. i.e. the ratio between signal and background is the most important information for quality control (Column 17, lines 25-36).

Applicant further argues that Lockhart "cannot be modified" by Bao et al because, "in Lockhart, hybridization data of a probe to the target sample and to the non-target sample are

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used independently and separately, e.g., for comparing hybridization signals between a probe and its mismatch control and for developing separate hybridization rules and cross-hybridization rules. Such methods cannot be practiced using a ratio between hybridization signal to the target sample and cross-hybridization signal to the non-target sample." The argument has been considered but is not found persuasive because, contrary to Applicant's assertion, Lockhart specifically comparing hybridization signals to evaluate probe binding (Column 36, lines 25-28). As such, the hybridizations of target and non-target samples are not independent and separate, but integral to their method for probe evaluation (Column 36, lines 25-47).

Applicant argues that Brown et al does not teach the claimed invention and does not cure the deficiencies of Lockhart and Bao. The arguments have been considered but are not found persuasive for the reasons stated above regarding Lockhart and Bao.



BJ FORMAN, PH.D.
PRIMARY EXAMINER